

Application Serial No. 10/765,265  
Response to Amendment dated January 9, 2007  
Amendment dated April 9, 2007

**REMARKS**

This paper is submitted in response to the Office Action dated on January 9, 2007. Claims 1 and 12 have been amended. Claim 17 has been canceled. Claims 9 and 19-24 were previously withdrawn from consideration as a result of a Restriction Requirement contained in an Office Action dated September 29, 2006. Consequently, claims 1-8, 10-16, and 18 now remain in the application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and therefore request consideration of the application in this regard.

During preparation of this Response, Applicants discovered and corrected a typographical error in the language of claim 1. In particular, original claim 1 recites the term “”plrtially.” Claim 1 has been accordingly corrected so that it now recites, in pertinent part, the term “partially.” No new subject matter is introduced by this amendment.

In regard to the objection to the drawings, made pursuant to 37 CFR 1.83(a), one additional figure has been added to the specification, in accordance with 37 CFR 1.121(d) and further in accordance with the suggestions made in the Office Action, to cure the asserted deficiency in regard to claims 5 and 6. Moreover, the specification has been accordingly amended in the “In the drawings” section and after original paragraph [0037] to accordingly describe the new figure. No new subject matter is introduced into the application by the addition of this new figure or the description thereof.

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Accordingly, Applicants respectfully request that the objection to the drawings in regard to claims 5 and 6 be withdrawn.

With continued regard to the objection to the drawings, Applicants respectfully partially disagree therewith. In particular, Applicants disagree with the asserted objection in regard to claim 16. The objection asserts that “the forming equipment for forming the binding strips as claimed in claim 16 . . . must be shown.” (Office Action, p. 3). No such language is present in claim 16 which instead recites “an apparatus as claimed in claim 12, which further includes a displacement means for displacing the sheet of paper after the binding strip has been bound thereto, in a direction parallel to the feeding direction.” In fact, the displacement means is shown in the specification as elements [42] and [68] corresponding to two different embodiments. Similarly, the specification further shows such displacement means [42, 68] as displacing the sheet [12] in a direction parallel to the feeding direction. More particularly, the first direction is indicated by a first arrow immediately below elements [42, 68] while the feeding direction is indicated as arrow [14], which is parallel to the first arrow, as recited in claim 16. Accordingly, Applicants respectfully request that the objection to the drawings in regard to claim 16 be withdrawn.

With continued regard to the objections to the drawings, claim 17 has been canceled in accordance with the suggestion made in the Office Action. Accordingly, Applicants respectfully request that the objection to the drawings in regard to claim 17 also be withdrawn.

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In regard to the objection made to the oath or declaration, a supplemental declaration has been executed and submitted herewith. Accordingly, Applicants respectfully request that the objection in this regard be withdrawn.

The application was originally filed with 24 claims, of which claims 1-8 and 10-18 have been rejected.

Claims 12-18 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication 200210164230 to Hoffman (“Hoffman”). In the Office Action, the Rejection asserts:

Regarding claim 12, Hoffman discloses an apparatus 10 for binding a sheet of paper, which includes: a feed means 20 for feeding an end of the sheet of paper 14 to be bound into a partially folded binding strip 22 which defines a longitudinal axis, the folded binding strip having two portions angularly disposed to each other about a fold line (as shown in figures 6-1 1 of incorporated reference U.S. Patent 2,042,912), in a direction parallel to the longitudinal axis of the binding strip; and a reciprocating securing means 16 for securing the binding strip to the end of the sheet of paper.

(Office Action, p. 4).

Applicants respectfully disagree with the Rejection. While Hoffman teaches one direction (labeled as arrow “C”) in which the feed means [20] feeds an end [24] of the sheet of paper [14] in a direction parallel to the longitudinal axis of a binding strip [34], this direction does not direct the end [24] into the strip [34], as recited in claim 12. Rather, the direction “C” of Hoffman directs the end [24] of the sheet of paper [14] along with the binding strip [22], which is previously bound thereto. The directions labeled as

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“A,” “D,” and “E” merit no discussion since they are transverse to the axis of the binding strip [22], which is inconsistent with the recitation of claim 12.

Notwithstanding, in order to advance prosecution of this application toward allowance, independent claim 12 has been accordingly amended to more clearly define the invention recited in claim 12 over the teachings of Hoffman. In particular, claim 12 has been amended to recite “wherein the feed means directs the end of the sheet of paper toward the binding strip prior to . . . .” Accordingly, Applicants respectfully submit that independent claim 12 recites a combination of elements not taught or suggested in the cited prior art and should therefore be allowed.

Moreover, as claims 13-16 and 18 depend from allowable independent claim 12, and further as each of these claims recites a combination of elements not taught or suggested in the cited prior art, Applicants respectfully submit that claims 13-16 and 18 should be allowed as well.

Claims 1-8, 10, and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of U.S. Patent Publication 2002/0021951 to Debrunner et al. (“Debrunner”). In the Office Action, the Rejection asserts:

Regarding claim 1, Hoffman discloses a method (see figure 2) of binding a sheet of paper 14 which includes the steps of: feeding an end of a sheet of paper 14 to be bound into a partially folded elongate binding strip 22 which defines a longitudinal axis and has two portions angularly disposed to each other (as shown in figures 6-1 1 of incorporated reference U.S. Patent 2,042,912), the end of the sheet of paper being fed in a feed direction that is perpendicular to the longitudinal axis of the binding strip into a region between the two portions; and mating the end of the sheet of

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paper and the binding strip, with the end of the sheet of paper located in the region between the two portions.

Hoffman does not disclose that the sheet of paper is fed in a feed direction that is parallel to the longitudinal axis of the binding strip into a region between the two portions. Debrunner et al. teaches a method of binding in which a sheet of paper 3 is fed in a feed direction that is parallel to the longitudinal axis of a binding strip 8 for the purpose of aligning the sheet of paper 3 with the binding strip 8 prior to pressing. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the method of Hoffman with the feed direction of Debrunner et al. in order to have a binding system that flows in a straight path from contact of the paper with the binding strip to the pressing step.

(Office Action, p. 5-6).

Applicants respectfully disagree with the Rejection. In particular, even if the assertion therein were as stated, the Rejection fails to point out a teaching in Debrunner disclosing the sheet of paper [3] being fed in a direction . . . into a region between the two portions [of the binding strip], as recited in claim 1. The Rejection seems to be limited to an assertion of a direction of transport of the sheet of paper [3] “that is parallel to the longitudinal axis of a binding strip 8 for the purpose of aligning the sheet of paper 3 with the binding strip 8 prior to pressing.” In other words, the Rejection fails to demonstrate a teaching in Debrunner wherein the sheet of paper [3] is directed into a region between two portions of the binding strip [8]. In sum, the Rejection fails to demonstrate the combination of elements recited in claim 1, even when combining the teachings of Hoffman with those of Debrunner.

Moreover, the assertion made in the Rejection is erroneous. More specifically, Debrunner does not teach a “method of binding in which a sheet of paper 3 is fed in a

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feed direction that is parallel to the longitudinal axis of a binding strip 8 for the purpose of aligning the sheet of paper 3 with the binding strip 8 prior to pressing.” In fact, Debrunner does not teach any such feeding of the sheet of paper [3] toward a binding strip [8] whether for purposes of alignment or for any other purpose. Instead, Debrunner teaches feeding of the sheet of paper [3] along with the bonding strip [8] toward a pressing device [9] (Debrunner at FIG. 1).

Similarly, the Rejection is improper because it fails to demonstrate an express teaching or suggestion in either Hoffman or Debrunner to combine their respective teachings and thereby arrive at the invention of claim 1. Moreover, there is no implicit motivation to combine the teachings of these two references. In particular, the feed direction of Debrunner into the pressing device [9] is required and facilitated by the flat open orientation of the pressing device [9], the stable nature of the book that is being transported, and the laterally placed beads of glue [13] (see Debrunner at FIG. 1).

In contrast, the workpiece [14] of Hoffman, which may be a calendar, poster or the like (col. 1, par. 10) may not be as stable, in an upright position, as the book of Debrunner. Similarly, directing the workpiece [14] of Hoffman into a partially folded binding strip [22] in a direction that is parallel to the longitudinal axis of the binding strip [22] is not obvious, as a workpiece as described in Hoffman may, for example, buckle upon contacts with one of the ends of the binding strip [22]. In Hoffman, the feed directions of the workpiece [14] throughout the disclosed process is related to the desired automation in the tinning of multiple edges of a calendar, poster or the like

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(Hoffman at col. 1, par. 9). Had feeding of a workpiece such as a calendar in a direction as recited in claim 1 been obvious, Hoffman would have likely disclosed it, rather than teaching a relatively more complex U-shape process as disclosed therein.

In sum, contrary to what the Rejection asserts, the feed direction of Debrunner addresses a technical requirement that is different from the problem sought to be solved in Hoffman. Consequently, the Rejection fails to meet its burden to demonstrate an express or implied motivation to combine these two references to arrive at the invention of claim 1.

In conclusion, Applicants respectfully submit that the Rejection of claim 1 is improper. Accordingly, Applicants respectfully submit that independent claim 1 should be allowed.

Moreover, as claims 2-8, 10, and 11 either directly or indirectly depend from allowable independent claim 1, and further as each of these claims recites a combination of elements not taught or suggested in Hoffman alone or in view of Debrunner, Applicants respectfully submit that claims 2-8, 10, and 11 should be allowed as well.

### **Conclusion**

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this effect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

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Applicant does not believe that any fees are due in connection with this response, however, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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